

**REMARKS**

**I. Status of the Claims**

Claims 1-56 are now pending in this application. No claims have been amended herein.

**II. Rejection under 35 U.S.C. § 102(b)**

Claims 1-4 and 19-29 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,900,545 ("*Wisotzki*") for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

In response to Applicants' assertion that *Wisotzki* does not teach a method of protecting a keratinous fiber from extrinsic damage or a method of repairing a keratinous fiber following extrinsic damage, the Examiner states that "*Wisotzki et al.* clearly teach (see column 1) split ends caused by chemical treatment; chemical treatment is an extrinsic factor." See Continuation page of the Advisory Action (emphasis added).

However, the Examiner appears to have missed the point. Although *Wisotzki* may teach damage caused by extrinsic factors as the Examiner now claims, Applicants were pointing out, and maintain, that *Wisotzki* does not teach "protecting" a keratinous fiber from extrinsic damage or a method of "repairing" a keratinous fiber following extrinsic damage as defined in the present specification. Thus, the focus of Applicants' arguments was on protecting from and repairing extrinsic damage, and not on the source of damage.

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 U.S.P.Q.2d 1065, 1069 (Fed. Cir. 1999). In the present case, explicit definitions found in the present specification recite that the term "protected" means that the keratinous fibers demonstrated a greater degree of preservation of the  $\alpha$ -structure and the tensile strength and the term "repairing" means that the damaged keratinous fibers demonstrated an increase in  $\alpha$ -structure and/or tensile strength following treatment of damaged keratinous fibers with the compositions of the invention. See page 5.

In contrast, *Wisotzki* merely discusses the visual characteristics of the hair and teaches the reduction of the number of visually discernible split ends. See e.g., col. 1, lines 29-30 reciting "restore damaged hair to a healthy appearance" and col. 5, line 68-col. 6, line 2 reciting that the hair-regenerating effect was tested by splitting hair and "[t]he visually discernable split ends were then determined by counting." *Wisotzki* does not teach or suggest preservation of or an increase in  $\alpha$ -

structure and/or tensile strength of the hair. Accordingly, *Wisotzki* does not teach or suggest a method for "protecting" a keratinous fiber from extrinsic damage or a method of "repairing" a keratinous fiber following extrinsic damage as defined in the present specification.

With respect to claims 30-56, Applicants assert that *Wisotzki* does not teach heating the keratinous fiber, wherein the composition is applied prior to or during heating. Accordingly, for at least this additional reason, Applicants maintain that the claims 30-56 are not anticipated by *Wisotzki*.

For at least the foregoing reasons, Applicants assert that *Wisotzki* does not identically describe the subject matter of the present claims and thus, Applicants respectfully request that the rejection under 35 U.S.C. § 102 be withdrawn.

### III. Rejections under 35 U.S.C. § 103(a)

Claims 1-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wisotzki*, U.S. Patent No. 5,660,838 ("*Koga*"), U.S. Patent No. 5,641,477 ("*Syed*"), and U.S. Patent No. 5,866,111 ("*Felardos*") for the reasons set forth on pages 4 - 5 of the final Office Action dated February 21, 2002. Applicants respectfully traverse this rejection for the reasons of record.

As an initial matter, with respect to the limitation of claims 30-65 reciting heating the keratinous fiber, Applicants maintain that they can find no support in *Wisotzki* for the Examiner's previous statement that "heat is commonly utilized in waving formulations." Accordingly, Applicants again request that the Examiner

provide evidence of such a common use so that Applicants may respond to this assertion.

Further, as of record, Applicants maintain that the Examiner has failed to demonstrate the requisite suggestion or motivation to make the proposed combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) (emphasis in original). In the present case, there would have been no motivation or suggestion to combine the cited references.

As discussed above, *Wisotzki* does not teach or suggest a method of protecting a keratinous fiber nor a method repairing a keratinous fiber according to the present invention. The Examiner relies on *Syed*, *Koga*, and *Felardos* to cure the deficiencies of *Wisotzki*. However, each of the cited references is drawn to a very different invention for a very different purpose from any of the others: *Wisotzki* is drawn to "[a] composition for the regeneration of hair split-ends" (see Abstract); *Syed* is drawn to "a lanthionizing composition that comprises hydrogenated starch hydrolysate" (see Abstract); *Koga* is drawn to "[x]ylobiose-containing skin preparations for external use" (see Abstract); while *Felardos* is drawn to "new cosmetic compositions, in particular mascaras" (see Abstract). The Examiner simply has not demonstrated any suggestion or motivation for the proposed modification.

At least for the foregoing reasons, Applicants respectfully request withdrawal of this § 103(a) rejection.

**IV. Conclusion**

Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   


Anthony C. Tridico  
Reg. No. 45,958

Dated: July 22, 2002

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com